

REMARKS

In response to the election of species requirement, Applicants elect Species II, an apparatus and method for producing electromagnetic radiation with no exhaust chamber. Claims **55-131** read upon the elected species. This election is made with traverse. The traversal is set forth below.

The Examiner has stated that the present application contains claims directed to the following patentably distinct species:

Species I: An apparatus and method for producing electromagnetic radiation with an exhaust chamber.

Species II: An apparatus and method for producing electromagnetic radiation with no exhaust chamber.

Species III: An apparatus and method for producing electromagnetic radiation with a removal device.

Election / Restriction

Applicants provisionally elect Species II (claims **55-131**), with traverse, on the grounds discussed below.

Characterization of Species and Listing of Claims

From the Examiner's characterizations of Species I and III, it appears that the Examiner intended to encompass claims 1-54 within Species I ("... an exhaust chamber"), and claims 132-144 within Species III ("... a removal device").

Thus, by the process of elimination, it appears that the remaining claims, namely claims 55-131, are encompassed within Species II.

Regarding the characterization of Species II, Applicants respectfully note that none of the claims of the present application expressly recites that the apparatus has “no exhaust chamber”. Accordingly, Species II encompasses claims which include or do not include an exhaust chamber. Therefore, claims 55-91, 93-95, 100-119, and 124-131 of Species II are believed to be generic. Applicants respectfully submit that a more appropriate characterization of Species II would be “An apparatus and method for producing electromagnetic radiation with an electrically insulated flow generator”.

Traversal of Election of Species Requirement

Applicants respectfully submit that the Election of Species requirement is traversed, for either one of the following reasons:

- (1) Applicants respectfully submit that the claims corresponding to Species I - III are not directed to mutually exclusive “species” within the meaning of M.P.E.P. § 806.04 or 37 C.F.R. § 1.141; or
- (2) in the alternative, Applicants respectfully submit that it would not be a serious burden on the Examiner to search and examine Species I, II and III in the same application.

(1) Mutually Exclusive “Species”

M.P.E.P. § 806.04(e) provides that,

“Species are always the specifically different embodiments”. [italics in original; underlining added]

Even if two or more species are claimed, M.P.E.P. § 806.04(f) only provides that restriction will be proper,

“if the species are mutually exclusive. Claims to different species are mutually exclusive if one claim recites limitations disclosed for a first species but not a second, while a second claim recites limitations disclosed only for the second species and not the first.” [emphasis added]

In other words, in order for two claims to be directed to mutually exclusive “species”, one claim must recite limitations which according to the disclosure are found in a first species but not in a second, while a second claim must recite limitations disclosed only for the second species and not the first.

Applicants respectfully submit that Species I, II and III do not relate to different mutually exclusive “species” under the above test. Applicants respectfully note that the *disclosure* of the present application does not describe “alternative” or mutually exclusive embodiments, but rather, describes a single illustrative embodiment of the invention.

For example, in the single illustrative embodiment as shown in Figure 2, the apparatus 100 includes an exhaust chamber 110 (Species I), an electrically insulated flow generator 150 (Species II), and two removal devices (Species III), namely, a filter 144 within the separation and purification system 142, and a disposal valve 160. See also Applicants’ specification as originally filed, at page 29, line 30 to page 30, line 2, at page 31, lines 5-7, and at page 32, lines 14-19. Therefore, as the characterizing features of all three Species are present in the single embodiment described and shown in Figure 2, it is clear that these features are not “mutually exclusive”.

Thus, the three groups of claims identified by the Examiner are not mutually exclusive “species” as defined in M.P.E.P. § 806.04(e)-(f). Applicants therefore respectfully request that the restriction requirement be withdrawn.

(2) "Serious Burden"

M.P.E.P. § 803 provides that,

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent ... or distinct as claimed; and

(B) There would be a serious burden on the examiner if restriction is not required ... [emphasis added]

It is clear that both of the above criteria must be satisfied in order to support a restriction requirement. In this regard, M.P.E.P. § 803 expressly states,

If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions. [emphasis added]

Regarding the first of these two criteria, Applicants agree with the Examiner's view that the three groups of claims are patentably distinct from each other.

However, with respect to the second of these two necessary criteria for restriction, Applicants respectfully submit that examination of the claims in groups I through III in the present application would not impose any "serious burden" as contemplated in M.P.E.P. § 803.

In this regard, Applicants respectfully note that among the provisionally elected claims of Species II (claims 55-131), certain dependent claims further recite the characterizing features that the Examiner has associated with Species I and Species III. For example, dependent claims 96-99 and 120-123 recite features relating to an "exhaust chamber", which the Examiner has associated with

Species I. Similarly, dependent claim 92 further recites a removal device, namely, a filter for removing particulate contamination from the liquid, which the Examiner has associated with Species III.

Therefore, in order to adequately search and examine the claims of Species II (claims 55-131), including dependent claims 92, 96-99 and 120-123, the Examiner will already be required to conduct searching and examination in relation to the features that the Examiner views as characterizing features of Species I and Species III. Accordingly, as a proper examination of Species II will require searching and examination of the features of all three Species in any event, Applicants respectfully submit that it would not pose a serious burden to maintain all three Species in the present application.

Summary

In summary, Applicants provisionally elect Species II (claims 55-131) with traverse, and respectfully request favorable consideration of the foregoing reasons for traversal.

This election is made without prejudice or disclaimer. Applicants reserve the right to pursue the remaining claims in a divisional application.

Conclusion

Should there be any questions concerning this application, the Examiner is invited to contact the undersigned agent at the telephone number appearing below. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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